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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,984	10/13/2000	Shaw-Fen Sylvia Hu	A-357B	1047

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EXAMINER

GUCKER, STEPHEN

ART UNIT PAPER NUMBER

1647

DATE MAILED: 10/22/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/687,984

Applicant(s)

Hu

Examiner

Stephen Kucke

Group Art Unit

1647

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 8/2/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 30 & 45-50 is/are pending in the application.
- Of the above claim(s) 49-50 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 30 & 45-48 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 1647

Part III DETAILED ACTION

1. Applicant's election with traverse of Group I, claims 30 and 45-48 wherein X is SEQ ID NO:18 in Paper No. 7 is acknowledged. The traversal is on the grounds that the search of the entire application can be made without a serious burden because of the advanced state of bioinformatics and indexed databases. This is unpersuasive because each sequence requires a separate search to be performed in the prior art and in the databases which are doubling in size approximately every six months. The Examiner was initially of the impression that all of the sequences used in the claimed methods in the instant Application were fragments of a single larger sequence, like the parent Application, which would not be a burden to search. However, as Applicant admits, SEQ ID NOs 42, 44, and 46 are unique. Because the claims require the searching of a genus of 70% identity to each unique sequence, a search burden does indeed exist.

Due to the increased database load and search burden for sequence searching the prior art, the PTO is currently restricting all nucleotide sequence applications to a single sequence. This is consistent with 1232 OG 242(116) where it was noted that "up to ten (10) independent and distinct nucleotide sequences will be examined...". Due to the exponential growth of the prior art sequence databases, the PTO has interpreted "up to ten" as including one nucleotide sequence.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 49-50 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

Art Unit: 1647

3. The disclosure is objected to because of the following informalities: the specification on page 2, lines 11-12; page 11, lines 12 and 27-28; page 16, line 10; page 17, line 11; page 38, line 7; and page 47, lines 35-36 requires updating: please update any change in the status (abandoned, issued Patent No., etc.) of US Patent Application Nos. 08/182,183, 07/501,904, 07/576,316, and 07/855,413.

Appropriate correction is required.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1647

5. Claims 30 and 45-48 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over: (a) claims 1 and 20 of US 5,929,041; (b) claims 1 and 5 of US 5,837,681; (c) claims 1 and 3 of US 5,731,284; claims 1, 3, and 8 of US 5,641,750; (d) claims 1, 3, and 16 of US 5,641,749; and (e) claims 1, 4, 10, 12, and 20 of US 5,929,041. Although the conflicting claims are not identical, they are not patentably distinct from each other because the open language of the instant claims reads on full length GDNF and/or 70% identity to GDNF protein products of the patents, and the actual process of administering the GDNF protein product is the same between the instant claims and the patented claims (*Ex parte Novitski*, 26 USPQ 1391).

6. No claim is allowed.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gucker whose telephone number is (703) 308-6571. The examiner can normally be reached on Monday to Friday from 0930 to 1800. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623. The fax phone number for this Group is currently (703) 308-4242, but Applicant should confirm this by phoning the Examiner before faxing.

Serial Number: 09/687,984

Page 5

Art Unit: 1647

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

S6

Stephen Gucker

October 21, 2002

Gary L. Kunz
GARY KUNZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600